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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,665	10/10/2001	Kohichiro Kodama	KOD69A.001AUS	1390

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EXAMINER	
HARTMANN, GARY S	
ART UNIT	PAPER NUMBER
3671	

DATE MAILED: 03/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/976,665	KODAMA ET AL.	
	Examiner	Art Unit	
	Gary Hartmann	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5 and 9-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,9-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 February 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 2/11/2003. These drawings are approved. Note that brief and detailed descriptions of these drawings must be added to the specification.

Specification

2. The disclosure is objected to because it does not include brief and detailed descriptions of the newly added figures. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-5 and 9-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation of "continuously" is new matter because the term does not appear in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-5 and 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed in the 112 1st paragraph rejection above, the term "continuously" is not described in the specification. Therefore, the scopes of the claims are unascertainable. The term has been treated essentially as --linearly--.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 2, 5, 8, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of: Kushida (U.S. Patent 6,264,334); Gillner et al. (U.S. Patent 4,978,207); Voelker et al. (U.S. Patent 3,200,705); Cardarelli (U.S. Patent 2,164,985); Wing (U.S. Patent 1,930,917); and van Gelder (U.S. Patent 1,837,085). Each of these patents discloses a mirror situated along a roadway (Kushida, 2; Gillner et al., 1; Voelker et al., 14; Cardarelli, 6; Wing, 13; van Gelder, 6-9). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met. Regarding the limitations of installation along a centerline, note that the position in which the device was installed on the roadway is a standard practice design consideration. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the apparatus of any of the above devices as claimed in order

to convey information in a desired manner. In other words, positioning of a roadway marking device is not patentable because it is within the scope of standard design practice.

9. Claims 1, 3, 5, 8, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Anders (U.S. Patents 5,665,793 and 5,472,737) and Feuvray (U.S. Patent 4,248,001). Each of these patents discloses a luminescent paint to be placed as desired along a roadway (see abstracts of Anders; Feuvray, column 4, lines 61-68, for example). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met. Regarding the limitations of installation along a centerline, note that the position in which the device was installed on the roadway is a standard practice design consideration. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the apparatus of any of the above devices as claimed in order to convey information in a desired manner. In other words, positioning of a roadway marking device is not patentable because it is within the scope of standard design practice.

10. Claims 1, 4, 5, 8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of: Custers et al. (U.S. Patent 6,305,874); Swemer (U.S. Patent 5,042,894); Eigenmann (U.S. Patent 4,993,868); Callhan (U.S. Patent 4,737,049); and Wyckoff (U.S. Patent 4,069,787). Each of these patents discloses an optical fiber placed along a roadway (Custers et al., Figure 1, for example; Swemer, abstract; Eigenmann, Figure 3A, for example; Callhan, Figure 13, for example; Wyckoff, column 3, lines 29-63, for example). Because a turn signal of an oncoming vehicle would inherently be reflected, the claim limitations are met. Regarding the limitations of installation along a centerline, note that the position in which the device was installed on the roadway is a standard practice design consideration. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have placed the apparatus of any of the above devices as claimed in order to convey information in a desired manner. In other words, positioning of a roadway marking device is not patentable because it is within the scope of standard design practice.

Response to Arguments

11. Applicant's arguments filed 2/11/2003 have been fully considered but they are not persuasive. Note that the newly added limitation of "continuously" introduces 112 1st and 2nd paragraph issues above. Further, as noted in the rejections, it is standard design practice to situate roadway markings or markers as desired in order to convey information in the most appropriate fashion. Therefore, the claims as presently recited are not patentable.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 703-305-4549. The examiner can normally be reached on Monday through Friday, 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 703-308-3870. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

gh
March 28, 2003

Gary Hartmann
Primary Examiner
Art Unit 3671